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EXAMINER

WILLIAMS, JAMILA O

ART UNIT PAPER NUMBER

3722

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/826,666

Applicant(s)

HOLMBERG, THOMAS A.

Examiner

Jamila O. Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-25 and 27-36 is/are rejected.
- 7) ☒ Claim(s) 16 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5/12/06.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☒ Other: DEFINITION.

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plastic overlay being attached proximate the binding edge of the sheet by the film strip, as recited in claim 21 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 19 is objected to because of the following informalities: in line 1 of claim 19 there is a lack of antecedent basis for "the film". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,4,9,10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by 3,581,423 to Mascolo. Mascolo discloses a sheet for an album comprising a sheet (11) having a binding edge (13 and column 1 lines 73-75 and column 2 lines 1-3) and an opposite, outside edge (where film 17 is attached), a film (17) attached to the sheet and extending along at least a portion of the opposite outside edge (figure 1-3).

Regarding claim 4, Mascolo discloses the film is wrapped around the outside edge so that a portion of the film is attached to each side of the sheet (figure 2-3).

Regarding claim 9, Mascolo discloses including a second film (12) attached adjacent the binding edge of the sheet (in that adjacent is defined as lying near or close to, element 12 satisfies this claimed limitation- see attached definition of adjacent).

Regarding claims 10-11, Mascolo discloses including a plastic overlay (plastic sheets 12) at least partially covering the sheet and wherein the plastic overlay is attached proximate the outside edge of the sheet by the film (see figure 2-3).

Claims 12 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by 1,023,715 to Bristol. Bristol discloses a sheet (26) having a binding edge and an opposite, outside edge (figure 1), a mounting strip (24) and a flexible film strip (30) connecting the mounting strip to the binding edge of the sheet such that there is a gap between the mounting strip and the sheet, wherein the flexible strip is wrapped around an outer spine edge of the mounting strip (figure 5 and 2 lines 26-42, the gap is shown clearly in figure 4) and wherein the mounting strip includes two or more post holes and the flexible film strip is adapted to reinforce the post holes (see figures 3 and 5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mascolo. Mascolo discloses all elements of the claims but for the film extending at least about 3/8" from the outside edge and the film being a polypropylene or polyester film.

Regarding claim 2, wherein the film extends at least about 3/8" from the outside edge, it would have been obvious to one having ordinary skill in the art at the time the

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invention was made to extend film 17 at least about 3/8", since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). It is also noted that applicant has given no criticality to this claimed value (page 4 1st paragraph of applicant's specification).

Regarding claims 3 and 5, wherein the film is polypropylene or polyester, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use polypropylene or polyester for strip 17, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. In re Leshin, 125 USPQ 416. It is also noted that applicant has given no criticality to the claimed materials (page 4 2nd paragraph of applicant's specification).

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mascolo. Mascolo discloses all elements of the claims including having the film 17 adhered to the sheet 12 with adhesive 20. However Mascolo does not disclose the specific type of adhesive (acrylic laminating, heat activated, pressure-sensitive).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use acrylic laminating, heat activated or pressure-sensitive with film 17, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. In re Leshin, 125 USPQ 416. It is also noted that applicant has given no

criticality to the claimed adhesive materials (page 4 2nd paragraph of applicant's specification).

Claims 12-15, 17-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mascolo in view of 1,023,715 to Bristol.

Mascolo discloses a sheet having a binding edge (13) and an opposite, outside edge (where film 17 is adhered). Mascolo does not however disclose the mounting strip and flexible film strip, as recited in claim 12.

Bristol teaches having a mounting strip (24 of figure 3) and a flexible film strip (30, figure 5) connecting the mounting strip to the binding edge of a sheet such that there is a gap between the mounting strip and the sheet (not clearly shown with the embodiment of figure 5 but see figure 4 which shows the gap between the sheet 26 and mounting strip 24), wherein the flexible film strip is wrapped around an outer, spine edge of the mounting strip (page 2 lines 26-42 of Bristol). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the film strip and mounting strip of Bristol with the sheet of Mascolo for the purpose of more securely mounting the sheets in a binder.

Regarding claims 13 and 14 wherein the mounting strip has a thickness of greater than the sheet or at least twice as thick as the sheet, it would have been an obvious matter of design choice to alter the size of the mounting strip, since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Additionally this it would have been obvious to one

having ordinary skill in the art at the time the invention was made make the mounting strip of greater thickness than the sheet or at least twice as thick as the sheet for the purpose of providing better reinforcement and durability of the assembly.

Regarding claim 17, Mascolo modified by Bristol discloses the mounting strip (24) includes two or more post holes (see figure 3) and the flexible film strip (30) is adapted to reinforce the post holes (this reinforcement occurs when 24 is provided between folded blank 30).

Regarding claim 15, Mascolo modified by Bristol discloses (in figure 5 and page 2 lines 26-42 of Bristol) having a mounting strip 24 and a flexible film strip 30 that is wrapped around an outer spine edge of the mounting strip. Bristol further teaches in figure 9 and page 2 lines 73-85 of Bristol) having a folded mounting strip 24,24'. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the folded mounting strip of figure 9 with the flexible film strip of figure 5 for the purpose of providing a more secure connection between the mounting strip and flexible film strip and for the purpose of accounting for sheets of unusual thickness.

Regarding claim 18, Mascolo modified by Bristol discloses further including a second film (17 of Mascolo) attached to the sheet (11 of Mascolo) and extending along at least a portion of the opposite outside edge (figure 2-3 of Mascolo).

Regarding claim 19, Mascolo modified by Bristol discloses the film (17 of Mascolo) is wrapped around the outside edge so that a portion of the film is attached to each side of the sheet (figure 2-3 of Mascolo).

Regarding claims 20 and 22, Mascolo modified by Bristol discloses a plastic overlay (12 of Mascolo) at least partially covering the sheet (11 of Mascolo); the overlay (12 of Mascolo) is attached proximate the outside edge of the sheet by a second film (17 of Mascolo).

Claims 20,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over 1,023,715 to Bristol view of 2,925,677 to Holes. Bristol discloses all elements of the claims as applied to claim 12 above (rejected under 35 U.S.C. 102b). Bristol does not however disclose having a plastic overlay and that the plastic overlay is attached proximate the binding edge of the sheet by the film strip. Holes teaches having a sheet 25 with plastic overlay (33,34,35) attached proximate the binding edge of the sheet by film strip (38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the overlay and teaching of having the overlay attached proximate the binding edge of the sheet by the film strip of Holes with the sheet and film strip of Bristol for the purpose of providing storage space on the sheets.

Claims 13-15,23-25,27 are rejected under 35 U.S.C. 103(a) as being unpatentable over 1,023,715 to Bristol. Bristol discloses all elements of the claims as applied to claim 12 above (rejected under 35 U.S.C. 102b). Bristol does not however disclose the thickness of the mounting strip as recited in claim 13-14,23,24.

It would have been an obvious matter of design choice to alter the size of the mounting strip, since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of

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ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Additionally this it would have been obvious to one having ordinary skill in the art at the time the invention was made make the mounting strip of greater thickness than the sheet or at least twice as thick as the sheet for the purpose of providing better reinforcement and durability of the assembly.

Regarding claims 15 and 25, wherein the mounting strip includes a folded sheet, Bristol discloses (in figure 5 and page 2 lines 26-42 of Bristol) having a mounting strip 24 and a flexible film strip 30 that is wrapped around an outer spine edge of the mounting strip. Bristol further teaches in figure 9 and page 2 lines 73-85 of Bristol) having a folded mounting strip 24,24'. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the folded mounting strip of figure 9 with the flexible film strip of figure 5 for the purpose of providing a more secure connection between the mounting strip and flexible film strip and for the purpose of accounting for sheets of unusual thickness.

Regarding claim 27, see the rejection of claim 17 (under 35 U.S.C 102b).

Claims 18-19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bristol in view of 2,925,677 to Holes. Bristol discloses all elements of the claims as applied to claim 12 (under 35 U.S.C 102b) and claim 23 above. Bristol does not however disclose including a second film attached to the sheet and extending along at least a portion of the opposite outside edge and wherein the film is wrapped around the outside edge so that a portion of the film is attached to each side of the sheet.

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Holes teaches having a sheet (10) with a film attached to the sheet and extending along a portion of the outside edge and the film being wrapped around the outside edge with a portion of the film attached to each side of the sheet (see figure 4 of Holes element 20 for example). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the second film as taught by Holes with the sheet of Bristol for the purpose of providing additional strength to the sheet and prevent undue wear caused by handling.

Regarding claim 29, 31,32 see rejections of claims 12,20 and 22 over Mascolo in view of Bristol above. Regarding claims 35-36, Mascolo modified by Bristol discloses a second plastic overlay applied to an opposite side of the sheet (figure 2 of Bristol shows overlay 12 on both sides of the sheet 11) and an adhesive applied to the sheet to hold the overlay against the sheet (14 of Mascolo).

Regarding claims 29, 30,32 see rejections of claims 20 and 21 over Bristol view of Holes above.

Regarding claim 33 wherein the plastic overlay includes an approximately 0.001" to approximately 0.003" polypropylene sheet, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a polypropylene sheet in this claimed range, since it has been held that discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mascolo in view of Bristol and further in view of 3,453,760 to Sonne. Mascolo modified by Bristol discloses all elements of the claims but for the plastic overlay having a static charge.

Sonne teaches having a photo album with sheets having a static charge (column 4 lines 5-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the static charge teaching of Sonne with the sheets of Mascolo (modified by Bristol) for the purpose of providing a more secure mounting structure for the photographs.

Allowable Subject Matter

Claims 16 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila O. Williams whose telephone number is 571-272-4431. The examiner can normally be reached on Monday-Friday 6:30am-3:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JW 11-20-2006


MONICA CARTER
SUPERVISORY PATENT EXAMINER